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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,574	12/12/2000	Wei-Min Liu	3364	5735

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EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,574

Applicant(s)

LIU ET AL.

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 7-13, 20-26 and 33-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14-19 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (1 sheet)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election of Group I (claims 1-6, 14-19, and 27-32) in the Paper, filed 1/9/04, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

NON-STATUTORY SUBJECT MATTER

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 14-19, and 27-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Consideration of the "Computer-Related Inventions" section of the MPEP at section 2106, Part IV, subpart B, has revealed that the instant claims are directed to non-statutory subject matter without requiring performance of a result outside of a computer. Thus, the manipulation of data or conversion of data, in this case probe array intensities is the claimed subject matter without any physical transformation outside of the computer. For example, said MPEP section also clarifies that claiming such non-statutory subject matter on a computer medium or in software does not prevent this rejection.

PRIOR ART

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1631

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 14-19, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al. (P/N 6,470,277); taken in view of the legal decision of In re Gulack [703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)].

Chin et al. describes methods of gene identification as summarized in the abstract. Columns 3-6 details practice of computer systems with various components such as memory etc. as set forth in certain instant claims. The data processing includes array data from hybridization assays for gene expression as cited in column 15, line 54, through column 16, line 42. This data is processed via a normalization factor as described in column 16, lines 36-42, and also required to be calculated as in the preamble of instant claim 1.

In re Gulack is a legal decision which indicates that nonfunctional descriptive material in a claim does not distinguish the prior art in terms of patentability. It is noted that this is also discussed in the MPEP at section 2106, part VI, last 2 paragraphs. In the instant claims the mathematical steps in the claims which calculate a specific normalization factor are nonfunctional because these steps result in a number but do

not control any function, such as a practical action or a physical transformation. Thus, these steps do not distinguish over the normalization factor practice as in the reference. A normalization factor is calculated in the reference in column 16, lines 4-25, as the arithmetic mean of the background data. The normalization factor calculation in the instant claims is not an action and thus the instant claims do not result in a function but rather is a conceptual result only.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to perform normalization factor calculation as in Chin et al. as in the instant claims wherein only nonfunctional descriptive material is additionally present in the instant claims which do not distinguish the claimed method over Chin et al. according to In re Gulack.

INFORMALITIES

The disclosure is objected to because of the following informalities:

At several citations in the specification as filed blanks are present which must be filled in or deleted. For example, such blanks are present on page 2, line 6; page 14, lines 18-20; and page 21, line 10.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See the specification on page 11, line 10. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Appropriate correction is required.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

March 19, 2004


ARDIN H. MARSCHEL
PRIMARY EXAMINER 3/19/04